Confirmation No.: 9070

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Robert H. Wollenberg	Examiner: Christopher M. Gross
Serial No.:	10/779,421	Group: Art Unit 1639
Filing Date:	February 13, 2004	Docket: T-6320 (538-66)
For:	HIGH THROUGHPUT SCREENING METHODS FOR LUBRICATING OIL COMPOSITIONS	Dated: May 7, 2008

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPELLANT'S BRIEF

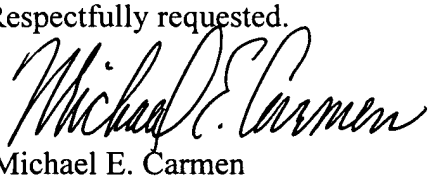
Sir:

Enclosed please find APPELLANT'S BRIEF.

Also enclosed is a check in the amount of $510.00 to cover the appeal fee.

Also, please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.17, or credit any overpayment of such fee(s) to Deposit Account No. 50-3591. Also, in the event any additional extensions of time are required, please treat this paper as a petition to extend the time as required and charge Deposit Account No. 50-3591. TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.

Respectfully requested.



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC:bg

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M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC:bg

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Alexandria, VA 22313-1450

APPELLANT'S BRIEF

Sir:

In response to the final Office Action dated July 31, 2007 and the Advisory Action dated March 10, 2008, Applicant appeals pursuant to the Notice of Appeal filed on December 28, 2007 and received in the U.S. Patent and Trademark Office on January 7, 2008. Pursuant to 37 C.F.R. §41.37, one copy of this brief is submitted in connection with the appeal which has been taken herein.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: MAIL STOP APPEAL BRIEF-PATENTS Commissioner for Patents, Alexandria, VA 22313-1450 on May 7, 2008.

Dated: May 7, 2008

Bridget Griffin

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(1) REAL PARTY IN INTEREST

The real party in interest for this application is Chevron Oronite Company LLC.

(2) RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences for this application.

(3) STATUS OF CLAIMS

Claims 1-21 and 33-35 are pending, stand rejected and are under appeal. All of these claims have been finally rejected and constitute the claims on appeal.

A copy of appealed Claims 1-21 and 33-35 as pending is presented in the Appendix.

(4) STATUS OF AMENDMENTS

Appellant's claims were finally rejected in a final Office Action mailed July 31, 2007. Appellant's submitted a Response on December 28, 2007 in response to the final Office Action. An Advisory Action was mailed on March 10, 2008 in which the Examiner maintained the rejection of Claims 1-21 and 33-35.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

One invention of the appealed claims directed to independent Claim 1 provides a high throughput method for screening lubricating oil composition samples for compatibility with elastomers under program control (page 1, lines 6 and 7, and page 4, lines 12-16 and 19-22). The first step of the method of the first invention includes providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one

base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive (page 4, line 23 through page 5, line 23, page 7, line 13 through page 16, line 15 and page 18, line 3 through page 21, line 12). The second step of the method of the first invention includes providing at least one elastomer (page 5, lines 2 and 3, and page 21, line 13 through page 22, line 2). The third step of the method of the first invention includes measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample (page 5, lines 3 and 4, and page 22, line 3 through page 25, line 10). The fourth step of the method of the first invention includes outputting the results of step (c), i.e., the third step, (page 5, lines 4 and 5, and page 25, line 21 through page 26, line 16).

A second invention of the appealed claims directed to independent Claim 33 provides a combinatorial lubricating oil composition library comprising lubricating oil composition elastomer compatability data stored on a programmed controller for a plurality of different lubricating oil compositions comprising (a) a major amount of a base oil of lubricating viscosity and (b) at least one lubricating oil additive. (page 6, line 21 through page 7, line 12 and page 26, line 7-16)

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection presented in this appeal are the following:

(1) Claims 1-3, 5-9 and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by Francisco et al. U.S. Patent No. 5,308,522 ("Francisco et al.").

(2) Claims 1, 2, 4, 5, 8 and 10-12 stand rejected under 35 U.S.C. §102(b) as being anticipated over Migdal et al. U.S. Patent No. 5,062,980 ("Migdal et al.").

(3) Claims 1-3, 5-9, 15-16 and 21 stand rejected under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Chaffee et al. U.S. Patent No. 4,774,281 ("Chaffee et al.").

(4) Claims 1-3, 5-9, 11-14, 17-21 and 33-35 stand rejected under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Kolosov et al. U.S. Patent Application Publication No. 2004/0123650 ("Kolosov et al.").

(5) Claims 1-3 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of U.S. Patent No. 7,137,289 in view of Francisco et al. and further in view of Bailey et al. U.S. Patent No. 3,108,397 ("Bailey et al.").

(6) Claims 1-3 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of co-pending U.S. Serial No. 11/528,747 in view of Bailey et al.

(7) Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending U.S. Serial No. 11/699,510 in view of Francisco et al.

(8) Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending U.S. Serial Nos. 11/605,127; 10/699,508; 10/699,507 and 10/779,422 in view of Francisco et al. and further in view of Guinther et al. U.S. Patent Application Publication No. 2004/0074452 ("Guinther et al.").

(7) ARGUMENT

A. Francisco et al. Fail to Anticipate Appealed Claims 1-3, 5-9 and 21

Francisco et al. disclose a lubricant composition containing (a) a major amount of a

lubricating oil basestock and (b) a minor amount of a benzotriazole for improving the load-carrying capacity of a lubricant composition under load conditions. Francisco et al. further disclose in Example 3 testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability by measuring the volume and tensile strength of a silicone elastomer specimen before and after it is contacted with a test formulation containing the desired load additive. The percent swell and percent change in tensile strength are calculated from these measurements and reported in Table 2 therein.

In contrast to the presently claimed invention, Francisco et al. fail to disclose a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in appealed Claim 1.

It is well established that, for a claim to be anticipated, a single prior art reference must disclose each and every element of the claimed invention, *either expressly or inherently. Lewmar Marine, Inc. v. Barient, Inc.,* 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987); *cert. denied,* 484 U.S. 1007 (1988). Certainly, Francisco et al. fail to disclose each and every element of the presently recited high throughput method conducted under program control of appealed Claim 1. The Examiner, however, has refused to recognize that the high throughput method, as set forth in the present claims, is conducted under program control, i.e., automated, such that a relatively large number of different lubricating oil composition samples can be rapidly prepared

and screened for elastomer compatibility data. Instead, the Examiner alleges that the recitations "high throughput" and "program control" deserve no patentable weight because the recitations are in the preamble of the claim. According to the Examiner, "[a] preamble is generally not accorded any patent weight where it merely cites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." citing *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

However, it is also well established that "[I]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Halliburton Energy Services Inc. v. M-I LLC*, 514 F3d 1244, 85 USPQ2d 1654, 1656 (Fed. Cir. 2008). Moreover, where the patentee has clearly indicated via the specification and the prosecution history that the invention provides an essential feature and that essential feature appears in a claim preamble, then that term as used in the preamble is "necessary to give life, meaning, and vitality to the claim," and may be used as a limitation. *MBO Laboratories Inc. v. Becton, Dickinson & Co.,* 474 F.3d 1323, 1330-31, 81 USPQ2d 1661, 1666 (Fed. Cir. 2007) *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 [51 USPQ2d 1161] (Fed. Cir. 1999) (quotation marks omitted).

The Examiner refuses to recognize that the recitation "high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control" in Claim 1 is necessary to give life, meaning and vitality to the present claims as the purpose of the claims is to conduct a high throughput method under program control, i.e.,

automated, such that a relatively large number of different lubricating oil composition samples can be rapidly prepared and screened for elastomer compatibility data. The specification clearly sets forth that the recitations "high throughput" and "program control" are essential features of the invention. For example, the specification sets forth on page 4, lines 12-16:

> Accordingly, it would be desirable to rapidly screen a plurality of sample candidate lubricating oil compositions for compatilibility with elastomers utilizing small amounts of each sample. In this manner, a high throughput preparation and screening of a vast number of diverse compositions can be achieved to identify which compositions are substantially compatible with elastomers.

The specification further sets forth on page 6, line 11 through page 7, line 12:

> The present invention is directed to a high throughput screening method for determining the compatibility of lubricating oil compositions with elastomers. The expression "high throughput" as used herein shall be understood to mean that a relatively large number of different lubricating oil compositions can be rapidly prepared and analyzed. In a first step of one embodiment of the screening method of the present invention, at least one lubricating oil composition is introduced in a plurality of respective test receptacles so that each receptacle contains a different lubricating oil composition having a different composition depending upon the percentage amounts and/or types of the at least one base oil and/or at least one additive combined in each receptacle.
>
> Data regarding the composition of each sample are stored in a data library. Adding the information related to the elastomer compatibility data of each of the stored compositions substantially facilitates the selection of candidate compositions capable of successfully carrying out the elastomer compatibility tests under the desired operating conditions or statutory requirements. Accordingly, storing this information in the combinatorial library not only allows for a rapid selection of multiple lubricating oil compositions in response to new requirements for a given test, but also becomes another piece of information in addition to, for example, storage stability, oxidation stability, wear stability,

dispersancy data, deposit formation data, etc., of the cataloged compositions. This information may also allow for calculating necessary changes of the additives at the least cost. The procedure is advantageously accomplished under program control and automatically controlled by, for example, a microprocessor or other computer control device. The expression "program control" as used herein shall be understood to mean the equipment used herein in providing the plurality of lubricating oil compositions is automated and controlled by a microprocessor or other computer control device.

The specification still further sets forth on page 22, line 3 through page 23, line 14:

Referring now to FIG. 2, a system for sequentially analyzing a plurality of fluid samples for elastomer compatibility is schematically illustrated. The samples can include lubricating oil compositions containing one or more base oils and one or more lubricating oil additives, such as those described herein. System 200 is schematically illustrated wherein an array of test receptacles 212 are mounted in a holder 215. The system 200 is adapted to accommodate any number of test receptacles 212 (and samples). Each sample is identifiable, for example, by the position of its test receptacle in an ordered array in holder 215, or more preferably by having an identifying mark associated with it. For example, each test receptacle 212 can include an identifying bar code 213 affixed to the outer surface thereof. A bar code reader 225 is positioned so as to be able to read the individual bar codes of the respective test receptacles 212 and to transmit a bar code data signal to a computer controller 230 via a data transmission line 226 to electronically identify the sample. The bar code reader 225 is preferably movable with respect to the holder 215 in response to a signal from computer controller 230 so as to be positionable in alignment with selected individual test receptacles 212.

A robotic assembly 250 includes a movable arm 251 with a grasping mechanism 252. The robotic assembly is adapted to grasp an individual test receptacle 212 in accordance with selection instructions from computer controller 230 and move the test receptacle to a position in testing station 220 so that the sample in the receptacle can be

> measured for elastomer compatability data. The robotic assembly is also adapted to grasp the elastomer (not shown) to be tested with the lubricating sample in accordance with selection instructions from computer controller 230 and move the elastomer to a position in testing station 220 so that testing of the elastomer and sample can be carried out. The computer controller 230 is operatively associated with controls to the robotic assembly via control signal transmission line 231 to selectively retrieve predetermined test receptacles and elastomers for measurement and then replace them in their assigned respective positions in the holder.
>
> Testing station 220 includes means for testing the samples for the compatibility with an elastomer. Elastomer compatibility data results of the test are converted to an electrical or optical signal and transmitted via signal transmission line 223 to computer controller 230. Various means for elastomer compatibility testing are known and generally include subjecting the sample to elastomer degradation conditions and measuring the elastomer compatibility, e.g., elastomer tensile strength measurement, elastomer elongation measurement, etc, of the sample over a predetermined period of time.

Clearly, then, the specification stresses that the recitations "high throughput" and "program control" are essential features of the method set forth in the appealed claims in order for a relatively large number of different lubricating oil composition samples to be rapidly prepared, screened for elastomer compatibility data and output the data. As such, the recitations "high throughput" and "program control" as recited in the preamble of appealed Claim 1 can only be regarded as necessary to give life, meaning, and vitality to the claim and may therefore be used as a limitation. Accordingly, the recitation "high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control" in appealed Claim 1 must be considered when determining patentability of the appealed claims.

Certainly, nothing in Francisco et al., much less Example 3 of Francisco et al., which has been relied upon by the Examiner, even remotely discloses a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in appealed Claim 1. In contrast, Example 3 of Francisco et al. simply disclose measuring elastomer compatibility for a commercially available amine phosphate additive against compounds I and II from Example 2 and reporting the measurements in Table 2 therein. Therefore, Francisco et al. do not disclose all of the elements and limitations of the claimed invention. Accordingly, the Examiner's position is untenable and in contrast to Federal Circuit precedent.

Additionally, nothing in Francisco et al. teach the limitations of appealed dependent Claims 2, 3, 5-9, and 21.

As set forth above, the presently claimed high throughput method for screening lubricating oil composition samples for compatibility with elastomers under program is different than the disclosure in Francisco et al. Accordingly, appealed Claims 1-3, 5-9, and 21 clearly possess novel subject matter relative to Francisco et al. and the rejection under 35 U.S.C. §102(b) should be withdrawn.

B. Migdal et al. Fail to Anticipate Appealed Claims 1, 2, 4, 5, 8 and 10-12

Migdal et al. likewise do not disclose each and every element of claimed invention. Specifically, Migdal et al. do not disclose a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in appealed Claim 1.

As with Francisco et al., the Examiner likewise alleges that the recitations "high throughput" and "program control" deserve no patentable weight because the recitations are in the preamble of the claim in rejecting Claims 1, 2, 4, 5, 8 and 10-12 over Migdal et al. Appellant submits that for the reasons discussed above, the recitations "high throughput" and "program control" as recited in the preamble of appealed Claim 1 can only be regarded as necessary to give life, meaning, and vitality to the claim and may therefore be used as a limitation. Thus, the recitation "high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control" in appealed Claim 1 must be considered when determining patentability of the appealed claims.

Accordingly, Migdal et al. is no more an anticipatory reference than Francisco et al. In contrast to the presently claimed invention, Migdal et al. disclose a novel additive which improves the dispersancy and Viton® Seal compatibility of a lubricating oil. Migdal et al. further disclose in Example X individually testing lubricating oil compositions containing the additive for Viton® Seal compatibility using an AK-6 Bend Test. Certainly, then, nothing in Migdal et al.,

much less Example X of Migdal et al., even remotely discloses a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in appealed Claim 1. Migdal et al. therefore cannot possible disclose all of the elements and limitations of the claimed invention. Accordingly, the Examiner's position is untenable and in contrast to Federal Circuit precedent.

Additionally, nothing in Migdal et al. teach the limitations of appealed dependent Claims 2, 4, 5, 8 and 10-12.

As set forth above, the presently claimed high throughput method for screening lubricating oil composition samples for compatibility with elastomers under program is different than the disclosure in Migdal et al. Accordingly, appealed Claims 1, 2, 4, 5, 8 and 10-12 clearly possess novel subject matter relative to Migdal et al. and the rejection under 35 U.S.C. §102(b) should be withdrawn.

C. The Combined References of Francisco et al. and Chaffee et al. Fail to Establish the *Prima Facie* Obviousness of the Method of Appealed Claims 1-3, 5-9, 15, 16 and 21

The deficiencies of Francisco et al. discussed above with respect to the rejection of Claim 1 apply with equal force to this rejection. Chaffee et al. is no more relevant a reference than Francisco et al. and does not cure and is not cited as curing the deficiencies of Francisco et al. In

fact, nothing in Chaffee et al. even remotely discloses a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in appealed Claim 1. Rather, Chaffee et al. simply disclose silicone rubber compositions that are individually tested for physical properties. As such, even by combining Chaffee et al. with Francisco et al., one skilled in the art would not even arrive at the claimed high throughput method conducted under program control. In contrast, one would simply arrive at individually testing the silicone rubber compositions of Chaffee et al. with the lubricant composition of Francisco et al. containing (a) a major amount of a lubricating oil basestock and (b) a minor amount of a benzotriazole. Accordingly, appealed Claims 1-3, 5-9, 15, 16 and 21 clearly possess nonobvious, and therefore patentable, over Francisco et al. and Chaffee et al. and the rejection under 35 U.S.C. §103(a) should be withdrawn.

D. The Combined References of Francisco et al. and Kolosov et al. Fail to Establish the *Prima Facie* Obviousness of the Method of Appealed Claims 1-3, 5-9, 11-14, 17-21 and 33-35

The deficiencies of Francisco et al. discussed above with respect to the rejection of Claim 1 apply with equal force to this rejection. Kolosov et al. do not cure the deficiencies of Francisco et al. Specifically, Kolosov et al. do not provide any teaching, motivation or suggestion that a plurality of different lubricating oil composition samples, each sample comprising (i) a major

amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, can be screened for the compatibility of the compositions with elastomers under program control in a high throughput method as presently recited in appealed Claim 1. Nor, for that matter, does Kolosov et al. provide any teaching, motivation or suggestion of a combinatorial library for storing lubricating oil composition elastomer compatability data on a programmed controller for a plurality of different lubricating oil compositions, as recited in present appealed Claim 33.

According to the Examiner [emphasis in original]:

> Here, Kolosov et al. state in paragraph 0043, "In one particular embodiment, the present invention is employed for screening flowable materials" Emphasis added. In this regard, according to MPEP 2124, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described in somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). In paragraph 0044, Kolosov et al. state further, "a polymer sample may be **heterogeneous**, and even further in paragraph 0048, that the polymer sample can, regardless of its particular form have various attributes including variations with respect to polarity, **solubility** and/or **miscibility**." Emphasis added. The examiner submits flowable materials represent a preferred embodiment for Kolosov et al. The examiner further submits elastomer samples are heterogenous with variations with respect to solubility and miscibility, and thus compatible with the robot of Kolosov et al.

However, the Examiner fails to recognize that the primary goal of Kolosov et al is to screen or test most any *flowable* material that may be a commercial product itself or may be an ingredient or portion within a commercial product for rheological properties or other properties which are density, melt index, thermal degradation, aging characteristics, weight-average molecular weight, number-average molecular weight, viscosity-average molecular weight, peak

molecular weight, approximate molecular weight, polydispersity index, molecular-weight-distribution shape, relative or absolute component concentration, chemical composition, conversion, concentration, mass, hydrodynamic radius, radius of gyration, chemical composition, amounts of residual monomer, presence and amounts of other low-molecular weight impurities in samples, particle or molecular size, intrinsic viscosity, molecular shape, molecular conformation, and/or agglomeration or assemblage of molecules. One such exemplary material disclosed in Kolosov et al. is a polymeric material. Kolosov et al. goes on to state in paragraph [0048] that "[I]n one embodiment, useful in connection with the screening of polymers, at a point prior to, during, or after depositing the sample onto the substrate, the sample is treated to form a flowable sample, such as a polymer solution, a polymer emulsion, a polymer dispersion or a polymer that is liquid in the pure state (i.e., a neat polymer), or a melt." Thus, according to Kolosov et al. the polymers can be employed in the method disclosed therein and may need to be dissolved, dispersed or emulsified to form a liquid sample.

Nothing in Kolosov et al. would therefore lead one skilled in the art to screen elastomers which are susceptible to serious deterioration from lubricating oil compositions containing (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive for elastomer compatibility of each lubricating oil composition sample in a high throughput manner under program control. Moreover, nothing in Francisco et al. discloses a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer

compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in appealed Claim 1. As such, nothing in Kolosov et al. would lead one skilled in the art to look to the method for screening or testing most any flowable material for rheological properties disclosed therein to modify the manual test of Francisco et al. for testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability with a test formulation containing the desired load additive, and arrive at the presently recited high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control. Furthermore, nothing in Kolosov et al. would lead one skilled in the art to look to the method for screening or testing most any flowable material for rheological properties disclosed therein to modify the disclosure in Francisco et al. of reporting the elastomer seal stability measurements in Table 2 manual of a commercially available amine phosphate additive and compounds I and II from Example 2 and arrive at the presently recited combinatorial library for storing lubricating oil composition elastomer compatability data on a programmed controller for a plurality of different lubricating oil compositions, as presently recited in appealed Claim 33. Accordingly, appealed Claims 1-3, 5-9, 11-14, 17-21 and 33-35 are nonobvious, and therefore patentable, over Kolosov et al. and Francisco et al. Thus, withdrawal of the rejection is warranted.

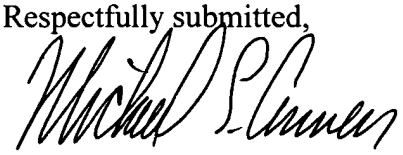
E. The Provisional Rejections Under the Judicially Created Doctrine of Obviousness-type Double Patenting

Upon resolution of all outstanding issues remaining in this application, Appellant will submit the necessary Terminal Disclaimers to obviate each of the provisional rejections.

F. CONCLUSION

For the foregoing reasons and for all of the reasons of record, it is submitted that appealed Claims 1-21 and 33-35 are patentable over the prior art relied upon by the Examiner. Reversal of the final rejections by the Board is therefore believed to be warranted, such being respectfully requested.

Respectfully submitted,



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicant

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC:bg

(8) CLAIMS APPENDIX

1. A high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of:

(a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive;

(b) providing at least one elastomer;

(c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and,

(d) outputting the results of step (c).

2. The method of claim 1, wherein the at least one base oil of lubricating viscosity is a natural or synthetic oil.

3. The method of claim 1, wherein the at least one lubricating oil additive is selected from the group consisting of antioxidants, anti-wear agents, detergents, rust inhibitors, dehazing agents, demulsifying agents, metal deactivating agents, friction modifiers, pour point depressants, antifoaming agents, co-solvents, package compatibilisers, corrosion-inhibitors, ashless dispersants, dyes, extreme pressure agents and mixtures thereof.

4. The method of claim 1, wherein the at least one elastomer is selected from the group consisting of olefinic elastomers, styrenic elastomers, poly(ether/ester) elastomers, polyacrylate elastomers, natural rubbers, synthetic rubbers, elastomer seals and mixtures thereof.

5. The method of claim 1, wherein the at least one elastomer is an elastomer seal.

6. The method of claim 1, wherein the step of measuring the elastomer compatibility of each sample comprises immersing the at least one elastomer in the sample at a predetermined temperature for a predetermined period of time and measuring the tensile strength and/or elongation of the elastomer to determine the elastomer compatibility of the sample.

7. The method of claim 6, wherein the predetermined temperature is about 100°C to about 400°C and the predetermined time is about 100 hours to about 400 hours.

8. The method of claim 1, wherein the elastomer compatability measurement of step (c) comprises a tensile strength measurement or an elongation measurement.

9. The method of claim 8, wherein the tensile strength measurement is compared with a predetermined tensile strength measurement of the elastomer.

10. The method of claim 8, wherein the elongation measurement is compared with a predetermined elongation measurement of the elastomer.

11. The method of claim 1, wherein the lubricating oil composition test samples have a volume of no more than about 50 ml.

12. The method of claim 1, wherein the lubricating oil composition test samples have a volume of no more than about 20 ml.

13. The method of claim 1, wherein the lubricating oil composition test samples have a volume of no more than about 15 ml.

14. The method of claim 1, wherein the lubricating oil composition test samples have a volume of no more than about 10 ml.

15. The method of claim 6, further comprising thermally conditioning the elastomer prior to immersing the elastomer in the sample.

16. The method of claim 15, wherein the elastomer is thermally conditioned at a temperature of about 100°C to about 200°C for about 20 hours to about 60 hours.

17. The method of claim 1, wherein a robotic assembly selectively retrieves the individual test receptacles from an array of test receptacles and selectively retrieves the at least one elastomer and individually positions the test receptacles and the at least one elastomer in a testing station for determination of the elastomer compatability.

18. The method of claim 17, wherein the robotic assembly is controlled by a computer.

19. The method of claim 1, wherein the step of outputting comprises storing the result of step (c) on a data carrier.

20. The method of claim 1, further comprising the step of using the result of step (d) as a basis for obtaining a result of further calculations.

21. The method of claim 1, wherein the at least one lubricating oil additive of the lubricating oil composition further comprises a diluent oil to form an additive concentrate.

33. A combinatorial lubricating oil composition library comprising lubricating oil composition elastomer compatability data stored on a programmed controller for a plurality of different lubricating oil compositions comprising (a) a major amount of a base oil of lubricating viscosity and (b) at least one lubricating oil additive.

34. The combinatorial library of claim 33, wherein the lubricating oil composition elastomer compatability data is selected from the group consisting of tensile strength measurements, elongation measurements, and combinations thereof.

35. The combinatorial library of claim 33, wherein the controller is a computer or microprocessor.

(9) EVIDENCE APPENDIX

None

(10) RELATED PROCEEDINGS APPENDIX

None